6/4/02

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Paper No. 9
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re ALJO OPTICAL ASSOCIATES, LTD.

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Serial No. 75/777,480

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John R. Crossman of Chapman and Cutler for ALJO OPTICAL ASSOCIATES, LTD.

Rudy R. Singleton, Trademark Examining Attorney, Law Office 109 (Ronald Sussman, Managing Attorney).

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Before Cissel, Wendel and Bucher, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On August 17, 1999, applicant filed the above-referenced application to register the mark "OPTICAL ON SITE" on the Principal Register for "optical goods sold via e-commerce and at retail, and manufacture and wholesale supply of optical goods to others, namely frames, lenses, and contact lenses and solutions and accessories to others, in International Class 9," and "optometric services, namely providing optical exams at retail locations and also to

employees of other companies at those companies' locations, and administering optical health benefits to companies and their employees, in International Class 42." The stated basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in connection with these goods and services in commerce.

The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. Section 1052(e)(1), on the ground that the mark applicant seeks to register is merely descriptive of the services set forth in the application.[1] In support of the refusal to register, he submitted dictionary definitions of the word "optical" as "of or relating to sight; visual… [and] designed to assist sight"; and the term "on-site" as "on or located at the site, as of a particular activity." He concluded that the mark is merely descriptive of the services with which applicant intends to use it because it merely describes "the type of service provided and where some of the

[1] Although applicant seems to have interpreted the refusal to extend to the goods in Class 9, the refusal and subsequent discussions of it by Examining Attorney, including in his brief on appeal, are consistently limited to the services of providing optical examinations at the locations where its customers work. Accordingly, we interpret the refusal to be limited to the services specified in the application, and not to include the goods.

services will be provided."

In addition to refusing registration, the Examining Attorney required applicant to amend the identification of goods and the recitation of services to eliminate indefinite terminology used in the application as filed.

Applicant responded to the first Office Action by amending the identification of goods and the recitation of services to read as follows: "optical goods, namely, frames, lenses, contact lenses, and accessories for each, namely eyeglass cases, contact lens fluids and cases, wiping cloths, and eyeglass chains and retainers," in Class 9; and "optometric services, namely providing optical examines[2] at retail locations and also to employees of other companies at those companies' locations," in Class 42.

Additionally, applicant argued that the refusal to register based on descriptiveness is not well taken, noting that no dictionary entry for the three-word combination term had been discovered by the Examining Attorney, and that applicant's own Internet search revealed no evidence of use of the combination term by anyone else in this field. Applicant provided a list of 224 pending and/or

[2] This appears to be a typographical error, and although it is repeated by applicant in subsequent communications, from applicant's brief it is clear that the word "examinations" is intended, instead of "examines."

registered marks from the United States Patent and Trademark Office's Trademark Electronic Search System which consist of or include either the term "ON-SITE" or "ON SITE," and argued that if these marks have been registered, applicant "should not be the only one held not to be entitled to register its trademark of choice."

The Examining Attorney accepted the amendments to the identification-of-goods clause and the recitation of services, but maintained and made final the refusal to register based on descriptiveness. Noting that third-party registrations may be used to establish the meaning of the words therein, the Examining Attorney attached a dozen third-party registrations for service marks that include the term "on-site." In each of these registrations the term was disclaimed unless the mark was registered on the Supplemental Register or on the Principal Register with a claim of acquired distinctiveness under Section 2(f) of the Act.

Also submitted by the Examining Attorney were excerpts from many published articles retrieved from the Nexis database wherein the term "on-site" is used in connection with services or goods provided at the location of the customer. For example, the January 18, 2001 edition of The Oregonian, in discussing a screening for glaucoma and other

eye diseases which was to be provided for free at a local medical Center, stated that "[a]n optometrist or ophthalmologist will be on site to interpret the test results." An excerpt from the July 26, 2000 edition of The Pittsburgh Post-Gazette, in discussing a local nursing home, commented that "[d]entists, podiatrists, optometrists and ophthalmologists are also on site." The April 18, 1999 edition of The Salt Lake Tribune stated that a local health fair was valuable because "doctors, dentists and optometrists were on hand to provide on-site medical evaluations and treatment."

Responsive to applicant's claim that there is no dictionary definition for the phrase "optical on site," the Examining Attorney noted that this fact is not determinative of registrability because the component terms of the phrase are merely descriptive of the services, and this descriptiveness is not eliminated when the words are combined.

Additionally, the Examining Attorney noted that the list of third-party registrations and applications submitted by applicant did not provide any information as to the nature of the services or goods with which the marks are used, whether or not the words therein are disclaimed, or whether the marks are registered on the Supplemental

Register or on the Principal Register in accordance with the provisions of Section 2(f) of the Act. Applicant was advised to submit either actual copies of the registrations or the electronic equivalents thereof, printouts taken from the Office's own computerized database.

Applicant timely filed a Notice of Appeal, followed by its brief on appeal.[3] The Examining Attorney then filed his brief on appeal, but applicant did not request an oral hearing before the Board. Accordingly, we have resolved this appeal based on consideration of the written record and the arguments presented by applicant and the Examining Attorney in their briefs.

The test for determining whether a mark is merely descriptive is well settled. A mark is merely descriptive under Section 2(e)(1) of the Lanham Act if it immediately and forthwith conveys information concerning a significant quality, characteristic, function, purpose or use of the

[3] Attached to applicant's brief were copies of the third-party registrations that applicant had listed in its response to the first Office Action. The Examining Attorney properly objected to the Board's consideration of this untimely-submitted evidence. Trademark Rule 2.142(d) states that the record closes with the filing of the Notice of Appeal unless applicant specifically asks the Board for permission to submit additional evidence after that point. In the instant case, applicant did not follow this procedure, so the late-filed evidence has not been considered. We hasten to add that even if we had considered these third-party registrations, we would have reached the same result in this case.

services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term describe all of the properties or characteristics of the services in order for it to be considered merely descriptive of them; rather, it is sufficient if a term describes any significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but rather in relation to the services for which registration is sought, the context in which it is being used (or is intended to be used) in connection with those services and the possible significance that the term would have to the average purchaser of them because of the manner of the term's use. See: In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). A mark is suggestive, rather than merely descriptive, if, when the services are encountered under the mark, a multi-stage reasoning process, or the use of imagination, thought or perception is required in order to determine what attributes of the services the mark indicates. In re Mayer-Beaton Corp., 223 USPQ 1347 (TTAB 1984). The Examining Attorney bears the burden of establishing that the mark is unregistrable because it is

merely descriptive of the services within the meaning of the Act. In re Gyulay, supra.

In the case at hand, the Examining Attorney has satisfied this test and met his burden of proof. The dictionary definitions of "optical" and "on-site," the third-party registrations and the excerpts from publications using "on-site" descriptively in connection with eye examination and treatment services as well as with other services which are rendered at the location of the customer all lead us to conclude that a prospective purchaser of applicant's services would understand the proposed mark as indicating that applicant's optical examination services are rendered at locations of its customers. As such, the proposed mark is merely descriptive of the services and is unregistrable under Section 2(e)(1) of the Act.

Applicant does not dispute the descriptive nature of "on site," or the descriptive significance of "optical" in connection with its services, but nonetheless argues that the Examining Attorney has not produced evidence which establishes descriptive use of the three-word combination it seeks to register, "OPTICAL ON SITE." As the Examining Attorney points out, however, in that this refusal is based on mere descriptiveness, rather than on genericness, his

burden was not to provide evidence that the combination of words sought to be registered is necessarily in use by others in connection with the services set forth in the application. Both "optical" and "on site" have been shown to be descriptive in connection with the services specified in the application, and applicant has not identified any non-descriptive significance that combining these two terms creates. A mark may still be held merely descriptive if applicant is the first, or the only, entity to have used it in connection with particular goods or services. In re Central Sprinkler Co., 49 USPQ2d 1194 (TTAB 1998).

In its appeal brief, applicant argues for the first time that "the double entendre-—between SITE in the mark and SIGHT for the object of optical services generally-—supports registration, making the mark of this application a bit incongruous, requiring a multi-stage reasoning process in a seeker of the optical goods or services." As the Examining Attorney points out, however, both "sight" and "site" are descriptive in connection with the services specified in the application, and applicant has not explained what commercial impression the mark in its entirety would evoke that would obviate the descriptiveness which this record establishes. It is possible that after lengthy consideration and analysis of applicant's mark in

connection with the services set forth in the application, a prospective purchaser might eventually recognize the possibility for double entendre to exist, but this conclusion would likely only be reached after a multi-stage reasoning or thought process, and that would run afoul of the requirement that the descriptive connotation must be "immediate and forthwith." The immediate meaning of the proposed mark in connection with these services is the descriptive one. The fact that the double entendre argument did not apparently even occur to counsel for applicant until he was writing the appeal brief in this case is telling evidence that the significance of the proposed mark based on double entendre would not be the primary significance attached to the mark. Moreover, even if it were clear that some minor double entendre would be engendered by the mark in connection with applicant's services, the mark would still be unregistrable because the primary significance would remain descriptive. See: In re Volvo Cars of North America, Inc., 46 USPQ2d 1445 (TTAB 1988).

Because "OPTICAL ON SITE" describes the fact that the services include optical examinations provided at the location of the customer, the mark is merely descriptive of

the services set forth in the application.

Decision: The refusal to register is affirmed as to the services in Class 42, and the application will proceed to publication only with respect to the goods in Class 9.